

REMARKS

In the Office Action, the Examiner rejected claims 1-15 and 21-27. By this paper, Applicants amended claims 1 and 4 to clarify features and amended claim 2 to correct a typographical error. No new matter was added. Further, these amendments do *not* necessitate a new search by the Examiner. Therefore, if the Examiner formulates a new ground of rejection in the next Office Action, it would be improper for the next Office Action to be made final. *See* M.P.E.P. § 706.07(a).

Claims 1-15 and 21-27 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections under Doctrine of Obviousness-Type Double Patenting

In the Office Action, the Examiner rejected claims 1, 3, 4, 6, 7, 9-15, and 21-27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (i) claims 1-25 of U.S. Patent No. 6,239,235, (ii) claims 1-19 of U.S. Patent No. 6,806,324, (iii) claims 1-9 of U.S. Patent No. 6,743,869, and (iv) claims 1-13 of U.S. Patent No. 6,815,511. Although Applicants do not agree that the present claims 1, 3, 4, 6, 7, 9-15, and 21-27 are obvious over the claims cited by the Examiner, Applicants will consider filing a terminal disclaimer if necessary when the present claims are indicated as allowable.

Applicants note the Examiner did not satisfy her burden of showing a correspondence between the present claims and the claims of the four patents. The Examiner must make the differences between the inventions defined by the conflicting claims and the reasons why a person of ordinary skill in the art would conclude that the invention defined in the present claims are obvious variations of the invention defined in the claims in the patents. See M.P.E.P. § 804 II.B.1., p.800-22, second column. Accordingly, for at least this reason, the four double patenting rejections are improper. Applicants respectfully request that the Examiner clarify these double patenting rejections and satisfy her burden of establishing a *prima facie* case of obviousness-type double patenting, or withdraw the rejection and allow the claims.

Further, Applicants note that the Examiner formulated both (1) a double-patenting rejection based on Hottovy, U.S. Patent No. 6,239,235 and (2) a rejection under 35 U.S.C. § 102(b) based on the same Hottovy, U.S. Patent No. 6,239,235. See Office Action, pages 2-4. This is improper. See, e.g., M.P.E.P. § 804 II.B.1., p. 800-22, first column (August, 2001 and Rev. 2, May 2004).

Claim Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 2, 5, and 8 under 35 U.S.C. § 112, First Paragraph, for failing to comply with the enablement requirement. The Examiner asserted that the “claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art . . . to make and/or use the invention.” Office Action, page 2. Applicants respectfully traverse these rejections.

Legal Precedent

Regarding the enablement requirement, the Examiner has the initial burden to establish a *reasonable basis* to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). The test for enablement, as set forth by the Supreme Court, is whether the experimentation needed to practice the invention is undue or unreasonable? *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). The *undue experimentation* test essentially evaluates whether one of reasonable skill in the art can make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991).

Deficiencies of the Rejection

Initially, Applicants note that claim 2 is amended in the present Response to correct a typographical error. Consequently, the Examiner's rejection of claim 2 under section 112 is believed to moot in light of the present amendment to claim 2. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 2 under 35 U.S.C. § 112.

As for claims 5 and 8, the Examiner contended that these two claims are not enabled because “the base of the percentage of the monomer is not defined.” *See* Office Action, page 2. Applicants respectfully traverse this contention. The base of the percentage of monomer (e.g., ethylene) is defined. *See, e.g.*, Specification, Examples I and II, pages 11 and 12, ¶¶ 36 and 27 (explaining that to calculate the percent ethylene, the “pounds of ethylene” in the reactor are divided by the “pounds of the liquid contents in the reactor”). Plainly, the percentage of monomer is based on dividing the mass of the monomer in the reactor by the total pounds of liquid in the reactor. Indeed, per the specification and the typical practice in the art, the monomer concentration is expressed as a weight percent of the liquid contents (not of the total contents – liquid and solid, for example) in the reactor. Clearly, undue experimentation is *not* required by one of ordinary skill in the art to make and use the presently-claimed invention with regard to knowing and understanding the basis of the percentage of monomer. *See, e.g.*, *U.S. v. Telectronics, Inc.*, 857 F.2d at 778. Applicants emphasize that claims 5 and 8 are enabled. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of claims 5 and 8 under 35 U.S.C. § 112, and allow the claims.

It should be further noted that claim 5 expresses the variation in monomer concentration as an absolute difference in percentage (e.g., 1.05%), a well-known methodology in the art. *See* page 2, ¶ 8. Moreover, again, the calculation basis of the underlying monomer (e.g., ethylene) concentrations in percent is clearly described in the specification, contrary to the Examiner’s assertion. *See, e.g.*, Specification, Examples I and II, pages 11 and 12, ¶¶ 36 and 27. Further, the specification provides additional

context by which one of ordinary skill in the art would reinforce their clear understanding of claim 5. For these reasons, Applicants respectfully request that the Examiner withdraw the rejection of claim 5 under 35 U.S.C. § 112.

Claim 8 expresses the variation in monomer concentration in the reactor as a standard deviation, also a well-known methodology. The underlying basis of the ethylene monomer concentration itself, again, is explained in the specification. *See, e.g.*, Specification, Examples I and II, pages 11 and 12, ¶¶ 36 and 27. *See* Specification, page 4, ¶ 15; page 7, ¶ 26. As with claim 5, the present specification provides additional context by which one of ordinary skill in the art would plainly be able to practice the claimed invention without undue experimentation. For these reasons, Applicants respectfully request that the Examiner withdraw the rejection of claim 8 under 35 U.S.C. § 112.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 3, 4, 6, 7, 9-15, and 21-27 under U.S.C. § 102(b) as anticipated by Hottovy et al. (U.S. Patent No. 6,239,235) and rejected claims 1-15 and 21-27 are rejected under 35 U.S.C. 102 (e) as being anticipated by Kendrick et al. (US 2002/0173598 A1, now US Patent No. 6,833,415). Claims 1 and 24 are independent. Applicant respectfully traverses these rejections.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). The prior art reference must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Further, if an Examiner is to rely on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference and so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). In relying upon the theory of inherency, the Examiner bears the evidentiary burden in providing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Deficiencies of the Rejection based on Hottovy

Independent claim 1, as amended, recites “introducing an olefin monomer to a loop reaction zone through a plurality of monomer feeds, *wherein the monomer feeds are substantially symmetrically arranged around the loop reaction zone.*” (Emphasis added).

Independent claim 24 recites “wherein the monomer feeds and the product take-offs are arranged *substantially symmetrically* about the loop reactor.” (Emphasis added). In contrast, Hottovy is absolutely devoid of arranging monomer feeds and/or product take-offs substantially symmetrically about the loop reactor. Therefore, Hottovy cannot anticipate claims 1 and 24, or their dependent claims.

Moreover, if the Examiner has relied on a theory of inherency in formulating the rejection, the Examiner has strikingly failed her evidentiary burden is showing that the claim features related to a substantially symmetrical arrangement *necessarily flows* or are *necessarily present* in Hottovy. *See In re Robertson*, 169 F.3d, at 743; *Ex parte Levy*, 17 U.S.P.Q.2d, at 1464.

In view of the foregoing amendment to claim 1 and the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of 35 U.S.C. § 102(b) based on the Hottovy reference.

Furthermore, while the present dependent claims are patentable because of the dependency on an allowable base claim, Applicants respectfully assert that the dependent claims are also patentable by virtue of the subject matter they separately recite. For example, the Hottovy reference fails to disclose or teach, or even suggest, the feature of “wherein each of the monomer feeds is *separately* controlled,” as recited by dependent claim 14, and the feature of “wherein the solid polyolefin particles have a molecular

weight distribution that is *unimodal*,” as recited by dependent claim 15. Indeed, Hottovy is absolutely devoid of these features, failing to even contemplate such features.

Therefore, Hottovy cannot anticipate dependent claims 14 and 15 for these reasons as well. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of claims 14 and 15 under 35 U.S.C. § 102(b) based on Hottovy for these additional reasons.

Deficiencies of the Rejection based on Kendrick

While Applicants choose *not* to fully address the content of Kendrick et al. (US 6,833,415) and believe Kendrick et al. to *not* be prior art, Applicants do note, for example, that the presently-claimed feature of “wherein each of the monomer feeds is separately controlled,” as recited by dependent claim 14, and the presently-claimed feature “wherein the solid polyolefin particles have a molecular weight distribution that is unimodal,” as recited by dependent claim 15 are notably absent from Kendrick et al. (US 6,833,415).

Applicants choose not to fully address the content of Kendrick and assert that Kendrick is not valid prior art because Applicants, in the previous Response (which is herein incorporated by reference), elected to remove Kendrick et al. (US 2002/0173598 A1, now issued as US 6,833,415) under 37 C.F.R. § 1.131. *See* Response to Final Office Action Mailed February 24, 2005, pages 10-17. Again, Applicants respectfully assert that the previously-submitted Rule 131 Declaration and the accompanying exhibits

sufficiently establish an earlier date of the invention of the subject matter disclosed and claimed in the present application. *See* Rule 131 Declaration of Donald W. Verser; Exhibits C, D, and E. These documents establish conception prior to the effective dates of the cited reference and, furthermore, establish diligence during the critical period from just prior to the effective date of the cited reference until constructive reduction to practice of the present application. *See* 37 C.F.R. § 1.131(b); M.P.E.P. §715.07(III). Therefore, Applicants believe that the cited reference should be removed pursuant to 37 C.F.R. § 1.131.

Applicants Do Not Provoke an Interference with Kendrick et al. (US 6,833,415)

With regard to Kendrick et al. (US 6,833,415), Applicants believe the appropriate path is to removed the Kendrick et al. (US 6,833,415) via the previously-submitted Rule 131 Declaration, as discussed above. If the Examiner disagrees with Applicants and believes that “the reference is claiming the same patentable invention,” and therefore, the previously-submitted “declaration of June 27, 2005 is inappropriate under 37 CFR 1.131(a),” it is the Examiner’s responsibility to initiate the interference, not Applicants. *See* M.P.E.P. Chapters 800 and 2300; Office Action, pages 4-5. .

The Examiner must either remove the reference under 37 C.F.R. § 1.131 or provoke an interference. For the Examiner to suggest or require otherwise demonstrates the Examiner’s misunderstanding of interference law and rules, including M.P.E.P § 2306. Lastly, Applicants note that if the Examiner provokes an interference, the Examiner is required to suggest claims for the interference. *See* M.P.E.P. Chapter 2300.

The Rejections of the Dependent Claims are Improper

Lastly, Applicants emphasize that in both rejections formulated by the Examiner under 35 U.S.C. § 102 (one based on Hottovy and the other based on Kendrick et al.), the Examiner failed to meet her burden under 35 U.S.C. § 102 in rejecting the dependent claims because the Examiner did not address the subject matter separately recited in the dependent claims. *See* Office Action, pages 3-4. To meet her burden of presenting a *prima facie* case of obviousness, the Examiner is required to address the specific elements of each and every claim rejected in the present application. *See In re Royka*, 180 U.S.P.Q. at 580; *In re Bond*, 15 U.S.P.Q.2d, at 1566. Applicants respectfully assert that pure conjecture will not do. *See* M.P.E.P. § 706.

Here, the Examiner fails to even address the subject matter of a single dependent claim, and therefore, the Examiner's rejections are incomplete and are unfairly wasting time and resources of the Applicants. Applicants must be given "a full and fair hearing." M.P.E.P. § 706.07. Further, Applicants respectfully remind the Examiner that she should never overlook the importance of her role in allowing claims which properly define the invention. MPEP § 706. Accordingly, for at least these reasons, Applicants traverse these unsupported rejections of the dependent claims. Given that the Examiner has not met his burden, the rejections of the dependent claims should be withdrawn.

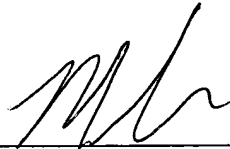
Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Authorization for Extensions of Time and Payment of Fees

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof. The Commissioner is authorized to any fees which may be required to advance prosecution to Deposit Account No. 06-1315; Order No. CPCM:0023/FLE.

Respectfully submitted,



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